

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-8 are now present in this application. Claims 1, 2, 7 and 8 are independent.

By this Amendment, amendments have been made to the Abstract of the Disclosure and specification, claim 9 is canceled, and claims 1-8 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed on August 2, 2006, and for providing Applicants with an initialed copy of the PTO/SB/08 form filed therewith.

Drawings

Applicants acknowledge receipt of the indication on the Form PTIOL-326 that the drawings filed on January 26, 2007 are accepted.

Objection to the Abstract of the Disclosure

The Examiner has objected to the Abstract of the Disclosure because of a grammatical issue.

In order to overcome this objection, Applicants have amended the Abstract of the Disclosure in accordance with the Examiner's suggestion. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Specification Objection

The Examiner has objected to the specification because of several informalities. In order to overcome this objection, Applicants have amended the specification in order to correct the deficiencies pointed out by the Examiner.

With respect to use in the specification of the terminology "mechanism CAD system" Applicant respectfully submits that its meaning is clear and definite in that a "mechanism CAD system" is understood by one of ordinary skill in the art as a CAD system used with a mechanism.

With respect to the "numbering operation" and "numbering system" issues, Applicant respectfully submits that the specification clearly identifies that different conventional CAD systems manage their data using their own identification numbers and that an integrated CAD system uses a numbering operation to keep the unified CAD data properly numbered. Applicants also respectfully submits that one of ordinary skill in the art clearly understands that such

conventional numbering systems are readily understood by one of ordinary skill in the art and/or are derivable by one of ordinary skill; in the art without undue experimentation.

Reconsideration and reconsideration and withdrawal of this objection are respectfully requested.

Claim Objections

The Examiner has objected to claims 5, 8 and 9 because of several informalities. In order to overcome this objection, Applicants have amended claims 5 and 8 in order to correct the deficiencies pointed out by the Examiner, and have mooted the objection to claim 9, which has been canceled. Reconsideration and withdrawal of this objection are respectfully requested.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-5, 7 and 9 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

Initially, Applicant notes that the rejection is moot with respect to claim 9, which has been canceled.

The test for compliance with the second paragraph of 35 U.S.C. §112, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994), is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no

more. *See also In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See also In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Moreover, this claim recites "substantially." Use of that term in a claim does not render the claim indefinite if the specification provides a standard whereby one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. *See Seattle Box Co., Inc. v. Industrial Coating and packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-4 (Fed. Cir. 1984).

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *See In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

Applicant respectfully submits that the claims fully comply with 35 U.S.C. §112, second paragraph as they stand and because one of ordinary skill in the art can readily determine the metes and bounds of the invention.

With respect to the language "virtually shared state," Applicant respectfully submits that the meaning of that language is clear to one of ordinary skill in the art from reading the specification and the amended claims.

Applicant also notes that the claims have been amended such that they are not written in "means-plus-function" format and so that all of the issues based on claims being written in this

format have been obviated. Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 101

Claims 1, 7 and 8 stand rejected under 35 USC §101 for being directed to Nonstatutory subject matter. This rejection is respectfully traversed.

Claims 1, 7 and 8 have been amended to fully comply with the requirements of 35 USC §101 in that the method of claim 1 is recited as a computerized method which displays geometrical information for use in development of a product, the system claims are clearly tied to a computer with a display for displaying the geometrical information for use in development of a product, and claim 7 recites a computer program embodied in or on a computer readable medium, thereby complying with the requirements of 35 USC §101..

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 3, 5 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright et al. ("Wright"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in

accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1, as amended, recites a computerized design parameter managing method for managing design parameters used respectively in a plurality of different CAD systems, comprising: performing computerized separation of CAD data used, respectively, in the plurality of CAD systems into geometrical information and attribute information; performing computerized setting up of arbitrary design parameters among design parameters used respectively in the plurality of different CAD systems into a virtually shared state among the plurality of different CAD systems; performing computerized correlation of the separated attribute information with the parameters set up into the virtually shared state; performing computerized accessing and recognizing of the separated attribute information correlated with the parameters set up into the virtually shared state among CAD data used respectively in the respective CAD systems; performing computerized management of geometrical information of the parameters set up into the virtually shared state which are correlated with the accessed and recognized attribute information as objects with data compatibility in the plurality of different CAD systems; performing management of geometrical

information other than that of the parameters set up into the virtually shared state which are correlated with the accessed and recognized attribute information as objects without data compatibility in the plurality of different CAD systems; and displaying the geometrical information for use in development of a product.

Claim 2, as amended, recites a computerized design parameter managing system for managing design parameters used respectively in a plurality of different CAD systems, comprising: a computerized system component for separating CAD data used respectively in the plurality of different CAD systems into geometrical information and attribute information; a computerized system component for setting up arbitrary design parameters among the design parameters used respectively in the plurality of different CAD systems into a virtually shared state among the plurality of different CAD systems; a computerized system component for correlating the separated attribute data with the parameters set up into the virtually shared state; a computerized system component for accessing and recognizing the separated attribute data correlated with the parameters set up into the virtually shared state among the CAD data used respectively in the plurality of different CAD systems; a computerized system component for managing geometrical information of the parameters set up into the virtually shared state which are correlated with the separated attribute data as objects with data compatibility in the plurality of different CAD systems; a computerized system component for managing geometrical information other than that of the parameters set up into the virtually shared state which are correlated with the separated attribute information as objects without data compatibility in the plurality of different CAD systems; and a display for displaying the geometrical information for use in development of a product.

Applicants respectfully submit that Wright does not anticipate the subject matter of claims 1, 2, 3, 5 and 7. For example, Wright contains no disclosure of performing computerized separation of CAD data used, respectively, in the plurality of CAD systems into geometrical information and attribute information, as recited in claim 1, or a computerized system component for separating CAD data used respectively in the plurality of different CAD systems into geometrical information and attribute information, as recited in claims 2, 3 and 5, or a computer program embodied on or in a computer readable medium for executing the design parameter managing method of claim 1 as recited in claim 7. Nor does Wright disclose the additional computerized method steps of claim 1, or the additional computerized system components of claims 2, 3 and 5, or the computer program embodied on or in a computer readable medium of claim 7.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3, 5 and 7 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright. Claim 6 stands rejected under 35 USC §103(a) as being unpatentable over Wright in view of U.S. patent application Publication 2003/0001839 to Tatsuhiro. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is

"the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refactories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital*

Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988(Fed. Cir. 2006) (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

In the sentence just prior to citing the *Kahn* case, the U.S. Supreme Court clearly stated that there has to be an apparent reason to combine the known elements in the manner claimed. The Office has the burden of making out a *prima facie* case of obviousness, i.e., by presenting objective factual evidence of a reason to combine the known elements in the manner claimed. The *KSR* decision did not lift that burden from the Office.

The articulated reasoning has to express a rationale explaining what would have led an ordinarily skilled artisan to combine selected features from each reference in a way that would have resulted in the claimed invention. See, *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, the Supreme Court reaffirmed the fundamental principles set forth in the *Graham v. John Deere Co.* decision, cited and discussed above.

Applicants respectfully submit that Wright fails to disclose the subject matter of claim 2, from which claims 4 and 6 depend, that Tatsuhiko fails to remedy the shortcomings of Wright

with respect to claim 2, and that claim 4 is not written in means-plus-function format (which forms the additional basis of this rejection of claim 6).

Accordingly, no matter how Wright is modified, neither Wright, nor Wright in view of Tatsuhiro can possibly render obvious the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 4 and 6

Reconsideration and withdrawal of this rejection are respectfully requested.

Additional References

Because none of the additionally cited references have been used to reject the claims, no comments need be directed to those references.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Application No.: 10/588,376
Art Unit 2128

Attorney Docket No. 1794-0187PUS1
Reply to Office Action dated September 9, 2009
Page 23

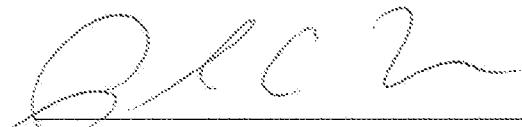
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: January 4, 2010

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Paul C. Lewis
Reg. No.: 43,368
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000

PCL/RJW:immi:jmc

Attachment: Abstract of the Disclosure